

NEW YORK CITY, 1970. THE PRINCIPAL DAY OF THE MONTH.

THE DAY OF THE COMPLAINT.

INTERVIEW

BY THE OFFICER OF THE POLICE DEPARTMENT OF NEW YORK

IN THE BUREAU OF INVESTIGATION

IN THE CITY OF NEW YORK

ON THE TWENTY-THREERD DAY OF JUNE, ONE THOUSAND NINETEEN

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IN THE
**Supreme Court of the United
States.**

NEW YORK SCAFFOLDING COMPANY,
Petitioner and Plaintiff below,

vs.

CHAIN BELT COMPANY and EGBERT
WHITNEY,
Respondents and Defendants below.

PARKINSON & LANE, Esqs.,
Marquette Building,
Chicago, Ill.

Sirs:

YOU WILL PLEASE TAKE NOTICE, that on Tuesday, October 2, 1917, at the opening of the court on that day, we shall present to the Supreme Court of the United States, in its court room, at the Capitol Building, in the City of Washington, D. C., the annexed petition for writ of certiorari and brief accompanying the same, copy of which petition and brief is herewith served on you.

Yours, etc.,

C. P. GOEPEL,
FRANK CHASE SOMES,
Counsel for Petitioner.

The foregoing notice is hereby accepted and delivery of a copy thereof and of a petition for writ of certiorari and brief accompanying the same is hereby acknowledged, this day of , 1917.

Counsel for Respondent.

IN THE SUPREME COURT OF THE
UNITED STATES,

OCTOBER TERM.

NEW YORK SCAFFOLDING COMPANY,
Plaintiff-Petitioner,

vs.

CHAIN BELT COMPANY and EGBERT
WHITNEY,
Defendants-Respondents.Petition for Writ of Certiorari to the U. S. Court
of Appeals for the Seventh Circuit.

To the Honorable, the Chief Justices and Associate Justices of the Supreme Court of the United States:

Your petitioner, New York Scaffolding Company, a corporation organized and existing under the laws of the State of New York, respectfully represents:

FIRST: That in the case at bar, the plaintiff brought suit on U. S. Letters Patent No. 959,008, to E. H. Henderson, in the District Court for the Eastern District of Wisconsin, against the Chain Belt Company, for infringement of said Letters Patent by the defendants for making scaffolding machines known as "Whitney Scaffold Hoist Machines" and "Little Wonder" machines. Before the trial of the cause, the real and instigating defendant, Egbert Whitney, intervened (U. S. Su-

preme Court, Rule No. 3), and after trial in open court, His Honor Judge Geiger (opinion, Tr., p. 310), held the patent valid and infringed by both of these machines when used in the Henderson combination. Appeal was taken by the defendants to the Court of Appeals for the Seventh Circuit, and this Court of Appeals thereupon held the patent valid, and infringed by the "Whitney Scaffold Hoists" machine, and not infringed by the "Little Wonder" machine. In arriving at this conclusion, the Court of Appeals for the Seventh Circuit had before it the opinion of the Circuit Court of Appeals for the Eighth Circuit on the "Whitney Scaffold Hoist" machine, holding the patent valid and infringed by the "Whitney Scaffold Hoist" machine, reported in 224 Fed., 452 (petition by defendant for writ of certiorari denied in 239 U. S., 640), and its later opinion as yet unreported holding the patent valid but not infringed by the "Little Wonder" machine (this later opinion is found in the transcript of record forming the basis of a petition for a writ of certiorari to the Court of Appeals for the Eighth Circuit in the case of *New York Scaffolding Co. v. Egbert Whitney*), as also the opinion of the Circuit Court of Appeals for the Third Circuit (opinion as yet unreported, but forming part of the transcript of record forming the basis for the petition for a writ of certiorari to the Court of Appeals for the Third Circuit, in the case of *New York Scaffolding Co. v. Liebel-Binney Construction Co. and Egbert Whitney*).

SECOND: That the Circuit Court of Appeals for the Seventh Circuit failed to apply the doctrine of equivalents when considering the "Little

Wonder" machines, since had it not overlooked to do so, it would have been lead to the conclusion that the hoisting mechanism of the "Little Wonder" machine and the hoisting mechanism of the Henderson machine are equivalents. The Henderson patent in suit, held to be valid by the Honorable Court of Appeals for the Seventh Circuit, expressly says:

"While I have shown my invention in the particular embodiment herein described, I do not, however, limit myself to this construction, but desire to claim any equivalent that will suggest itself to those skilled in the art."

The Honorable Court, therefore, went counter to the settled law of this court as expressed in one of its latest cases:

"We have seen DeBange describe what he conceived to be the best form of his invention, and contemplated that it could be represented in other forms and proportions. This, however, was unnecessary, for the law would secure him against imitation by other forms and proportions." (U. S. v. Societe Anonyme, 224 U. S., 309, 328, 56 L. Ed., 778, 787, 32 Sup. Ct., 479, 487.)

THIRD: The Henderson claims being *combination* claims, and, therefore, if valid, are entitled to a fair scope of equivalents of each of the co-operating elements constituting the life of the co-operative law underlying the combination, and especially that element which is least important in novelty is entitled to the greatest range of equivalents. This presents on this statement a novel question of patent law not as yet passed on by this Honorable Court.

FOURTH: That the Court of Appeals for the Seventh Circuit held that certain prior use evidence was sufficiently proven (though the trial court who *heard* and *saw* the witnesses who testified on memory only, without the production of an actual and old machine, held it to be insufficient), and thus overlooked the requirements as to proof as stated in The Barbed Wire Patent, 143 U. S., 275, 283; 36 L. Ed., 154, 158; 12 S. C., 443, 446.

FIFTH: That the Court of Appeals for the Seventh Circuit followed the decision of the Court of Appeals for the Eighth Circuit, filed April 2nd, 1917, which passed on the "Little Wonder" machine, which opinion is based on the error of fact pointed out in the petition and brief for a writ of certiorari to the Court of Appeals for the Eighth Circuit.

SIXTH: That in the face of the decision of this Court of Appeals for the Seventh Circuit, holding the patent in suit valid and infringed by the "Whitney Scaffold Hoist" machine, and in the face of the two decisions of the Court of Appeals for the Eighth Circuit (one reported in 224 Fed., 452, 140 C. C. A., 138, and the other as yet unreported, but found in the transcript of record of the case of N. Y. Scaffolding Co. v. Whitney, submitted in this court on a petition for a writ of certiorari) holding the Henderson patent valid, the Court of Appeals for the Third Circuit declared the Henderson patent invalid. That in each of these litigations, the same Egbert Whitney was a co-defendant, and in

view of these conflicting decisions, decrees will result having contrary effects.

If the decree in favor of Egbert Whitney in the Third Circuit controls, and is effectual "everywhere" (*Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 Sup. Ct., 611) the decrees against this same defendant, Egbert Whitney, of the Seventh and Eighth Circuits will have no force and effect against him. If, on the other hand, the decrees of the Seventh and Eighth Circuits, or either of them, control, they will do violence to this decree of the Third Circuit, unless made barren by exempting claims, as in *Consolidated Rubber Tire Co. v. Diamond Rubber Co.*, 162 Fed., 892, 89 C. C. A., 582, affirmed in *Diamond Co. v. Consolidated Co.*, 220 U. S., 428, 55 L. Ed., 527, 31 S. C., 444, in which event great confusion will also result.

But in the case at bar the defendant Egbert Whitney is one and the same defendant in these three litigations, so he could not be restrained and excluded in the same decree. In the Rubber Company case, *Rubber Tire Wheel Co. v. Milwaukee Co.*, 154 Fed., 358, 363, 83 C. C. A., 336, 341, Judge Baker said:

"The case in the Court of Appeals for the Sixth Circuit was not a proceeding in rem. The defendant in that particular suit has a decree on which, if he were again sued for infringement of the Grant patent, he could have a plea of *res adjudicata*. That plea would be as good in the other circuits as in the Sixth. No other member of the public could plead that decree in any circuit. The right conclusion of law from the facts found is that, so far as the parties to the con-

tract in suit are concerned, the patent is valid throughout the United States, and is enforceable against everyone who is not able to shield himself behind an erroneous decree. If any inference of fact (or prophecy) was to be drawn from the facts found, it should have been that the Court of Appeals for the Sixth Circuit will not exempt other members of the public from the monopoly of the Grant patent."

If Judge Baker's ruling in this Rubber Company case is correct, then the decrees of the Seventh and Eighth Circuits have no force and effect against Egbert Whitney in the Third Circuit.

In *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 S. C., 611, this Honorable Court said:

"It may be that the judgment in *Eldred v. Kessler* will not afford Breitwieser, a customer of Kessler, a defense to Eldred's suit against him. Upon that question we express no opinion. Neither it nor the case in which it is raised are before us."

But this court, as is seen, did not pass on this point.

In the later case of *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S., 428, 445, 55 L. Ed., 527, 536, 31 S. C., 444, 451, this Honorable Court said:

"The final contention of the rubber company is that, the Grant patent having been declared invalid by the Circuit Court of Appeals of the Sixth Circuit and by the Circuit Court for the District of Indiana in the Seventh Circuit, the rubber company should not have been enjoined from the handling or sale of tires manufactured

in the sixth and seventh circuits, and cites *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 Sup. Ct. Rep., 611."

But this Honorable Court did not decide this point.

In the case at bar, this point is squarely before this Honorable Court. Egbert Whitney is held by the Circuit Courts of Appeals for the Seventh and Eighth Circuits, an infringer by his "Whitney Scaffold Hoist" machine. By this, this judgment is good "everywhere and always," but Whitney, the same defendant, will claim that the Third Circuit excludes him. The question is: Do the Seventh and Eighth Circuits control, or does the Third Circuit control this defendant, Egbert Whitney, the same defendant in all three litigations?

We respectfully urge that the case at bar presents directly the issue undecided by this Honorable Court in either the *Kessler v. Eldred* or the *Grant Tire* cases, and, as the case at bar presents novel points of patent law, it should induce this court to allow this petition.

SEVENTH: The subject matter of this litigation is of great importance to the building trade, and the entire industry is interested in the definite and final decision of this litigation over the Henderson patent in issue.

WHEREFORE, your petitioner respectfully prays: That a writ of certiorari may be issued out of and under the seal of this Seventh Circuit, commanding the said court to certify and send to this court, on a certain day to be therein designated, a full and complete transcript of the record of all pro-

ceedings of the said Court of Appeals in the same case therein, entitled, New York Scaffolding Company *v.* Liebel-Binney Construction Company and Egbert Whitney, and decided August 10, 1917, to the end that the said case may be reviewed and determined by this court, and that your petitioner may have such other or further relief as to this Honorable Court may seem proper and appropriate.

NEW YORK SCAFFOLDING COMPANY,
Petitioner.
By C. P. GOEPEL,
F. C. SOMES.

I hereby certify that I am solicitor and of counsel for the petitioner herein, New York Scaffolding Company; that in accordance with the request of said petitioner, the foregoing petition has been prepared; that the allegations contained in said petition are true, to the best of my knowledge and belief; and that said petition is, in my opinion, well founded in law, as well as in fact.

C. P. GOEPEL,
F. C. SOMES,
Counsel for Petitioner.

IN THE SUPREME COURT OF THE
UNITED STATES,

OCTOBER TERM.

NEW YORK SCAFFOLDING COMPANY,
Plaintiff-Petitioner,

vs.

CHAIN BELT COMPANY and EGBERT
WHITNEY,
Defendants-Respondents.

**Brief in Favor of Granting the Petition for Writ
of Certiorari to the U. S. Court of Appeals
for the Seventh Circuit.**

To the Honorable Chief Justice, and Associate
Justices of the Supreme Court of the United
States:

FIRST: The Court of Appeals for the Seventh
Circuit held the patent in suit valid.

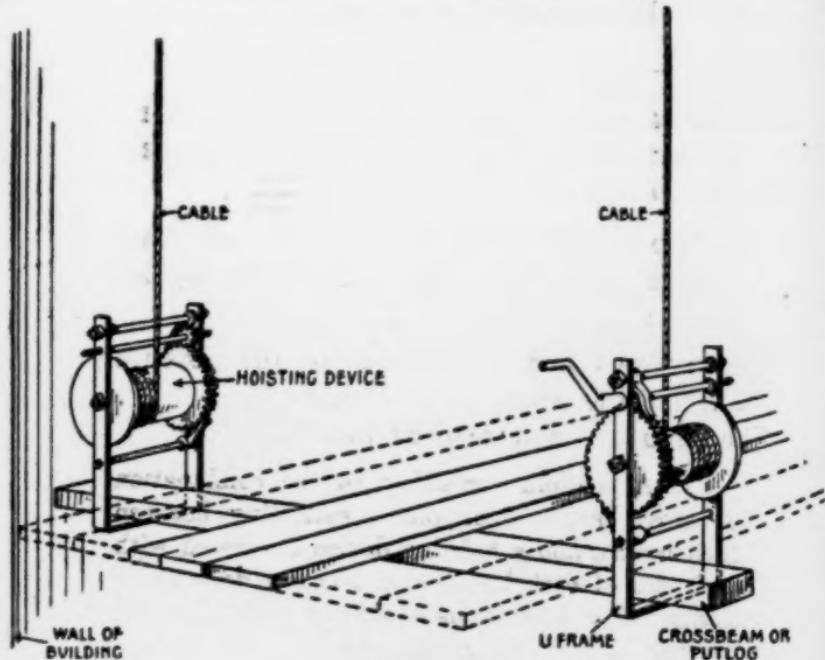
The claims in suit read as follows:

“1. A scaffold consisting in the combination
of cross beams, floor pieces extending between
such beams, and a hoisting device associated with
each end of each beam, each hoisting device con-
sisting of a continuous U-shaped metal bar ex-
tending around the under side of and upward
from the associated beam, and a hoisting drum
rotatably supported by the side members of such
bar.

3. A scaffold consisting of a plurality of U-

shaped bars arranged in pairs, a cross beam laid in and extending between each pair of such U-shaped bars, a floor laid upon said cross beam, a drum rotatably supported between the upwardly extending side members of each of said U-shaped bars, and means for controlling the rotation of said drum."

They comprise a combination, consisting of *pairs* of U-shaped frames, having hoisting mechanism, with putlogs or cross beams laid in or associated with the U-shaped frames, and with platform planks on the cross beams or putlogs.

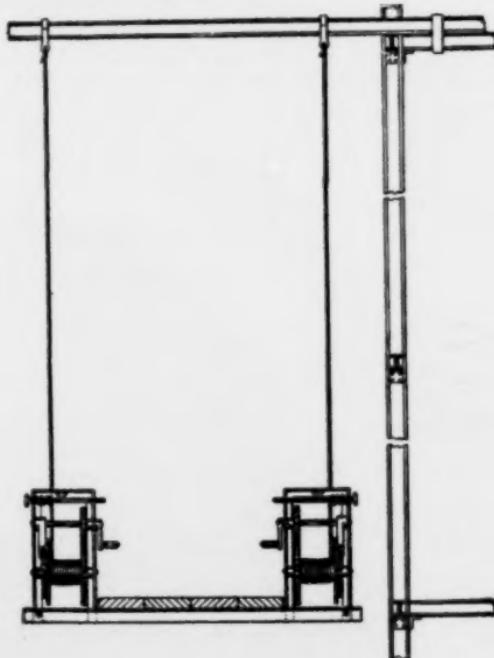


The "entirety" or "combination" consists in the *pairs* of U-shaped frames with hoisting mechanisms, cross beams or putlogs, and plat-

form planks, whereby a mason's platform is formed.

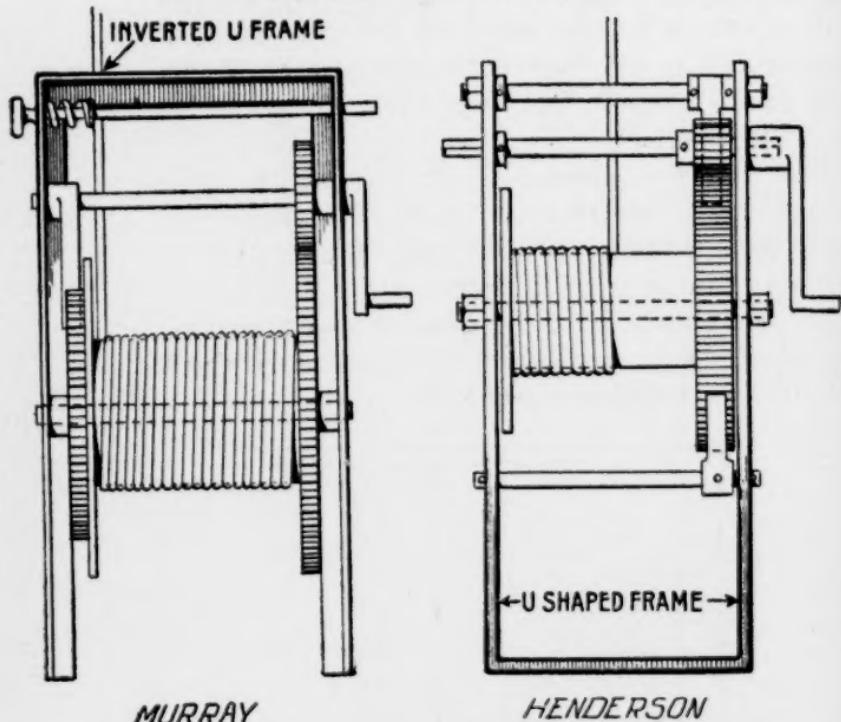
Bowyer's patent (Tr., p. 332) and Sladek's patent (Tr., p. 336) showed a *painter's stage*, not a mason's scaffold, having U-shaped frames with platform planks supported thereby, but only showed, as is the case with painter's scaffolds, *one* pair of frames. These old frames had hoisting mechanism.

The Murray patent No. 854,959 (Tr., p. 384) is the only platform mason's scaffold among the prior art, but this was practically junk. (Tr., p. 191.) It had *inverted* U frames with their lower-most free ends secured to cross beams or putlogs, on which platform planks were placed, and which frames had hoisting mechanism.



This is the only pertinent prior art patent, which attempted to solve the problem of platform machine scaffolding.

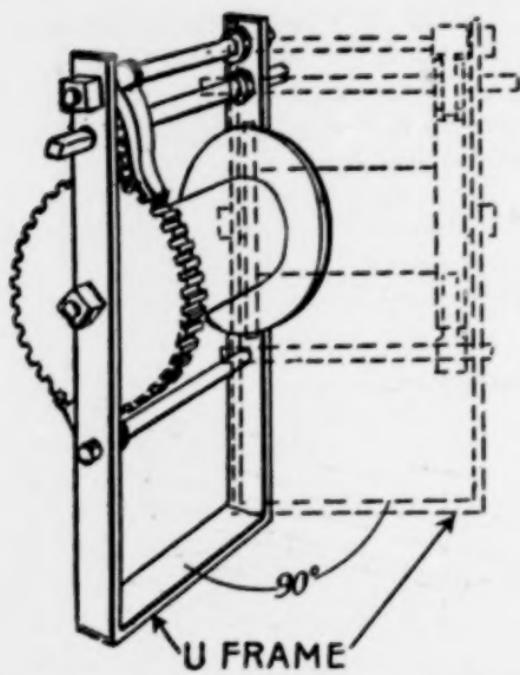
Henderson took the inverted U frame of Murray, turned it upside down,



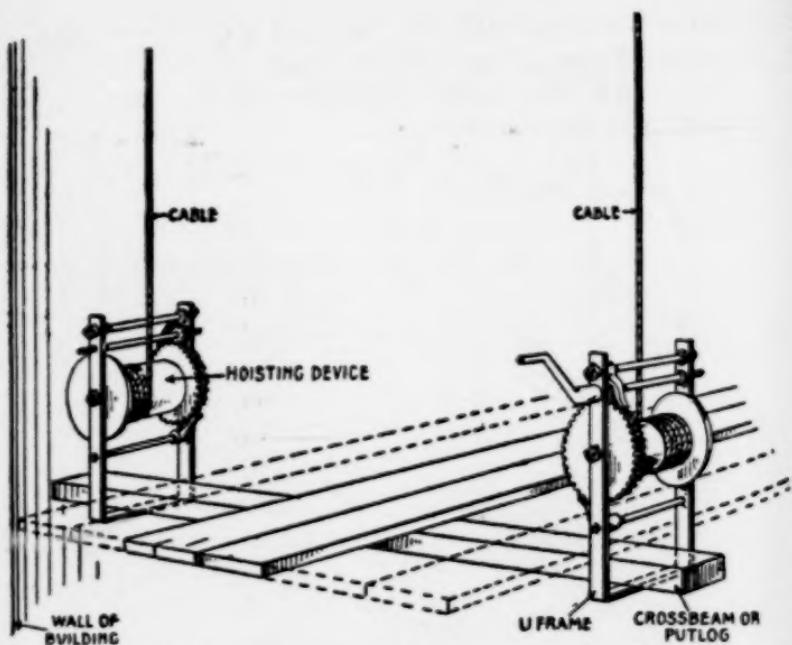
MURRAY

HENDERSON

and then in one of his embodiments, turned it at right angles to this position



and then placed into the U-shaped frame, now acting as a "stirrup," the cross beams or put-logs, and placed the



platform planks on the putlogs.

By the *loose* connections between the pairs of U-shaped frame stirrups and the putlogs, Henderson produced a new combination. As said by the Court of Appeals for the Eighth Circuit, in: 224 Fed., 452, at 458, 140 C. C. A., 138, 144:

"The combinations of Henderson's first and third claims were new. No one had made them before he disclosed them. They were not described or suggested in the prior art."

And at page 461, C. C. A., 147:

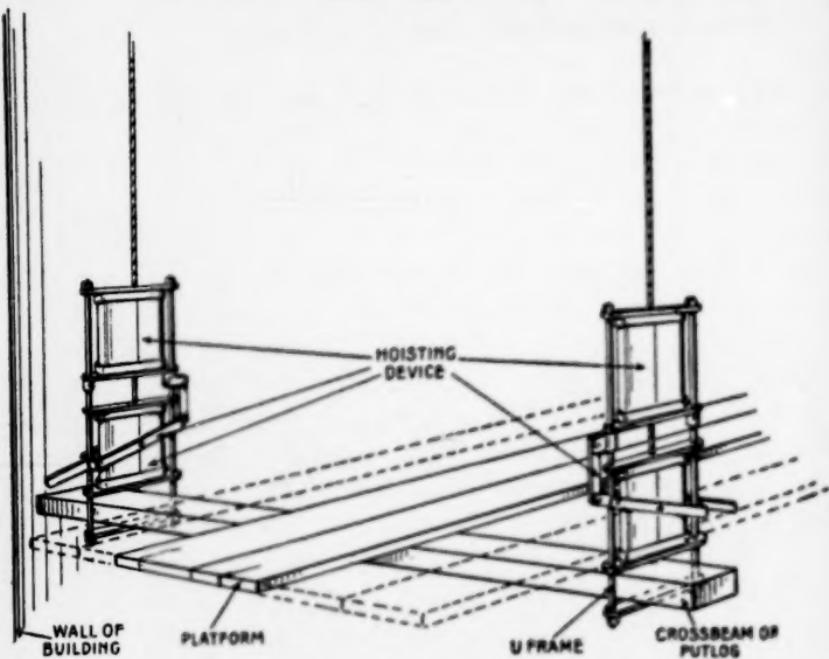
"The combinations of Henderson are unique in this: That the principle of his invention is embodied in the hoisting devices and their frames and their appropriate location in the combinations to such an extent that any contractor or

other person provided with them and taught their proper location, can readily supply the cross-pieces and floor pieces and make and use the patented combinations."

That a combination is always an entirety (*Schumacher v. Cornell*, 96 U. S., 549, 24 L. Ed., 676), and being such an entirety of a single combination of old elements is incapable of division or separate use (*Bates v. Coe*, 98 U. S., 31, 25 L. Ed., 68), it imposes as strict a rule on the plaintiff as on defendant. On the defendant, because such an entirety cannot be anticipated, except by the antiquity of the entirety (*Parks v. Booth*, 102 U. S., 96, 26 L. Ed., 54), and on the plaintiff, in that he cannot embrace a later structure, unless that structure embraces the entirety (*Paper Bag Patent Case*, 210 U. S., 405, 415, 52 L. Ed., 1122, 1126, 28 S. C., 748, 749). But just when defendant's device is embraced by the entirety, depends very often upon the doctrine of equivalents as applied to any or all of the separate members of the combination, and it is here wherein the Court of Appeals for the Seventh Circuit did not apply any equivalents. The invention, of course, must be described in the patent, and the mode of putting it to practical use, but the claims measure the invention. But in a combination claim, the principle of the invention is a unit, and invariably the modes of its embodiment in a concrete invention may be numerous, and in appearance very different from each other (*Robinson on Patents*, Sec. 485); the matter of equivalency is determined not by the difference in appearance, but by the identity of formation.

The "Little Wonder" machine has a rectangu-

lar frame, the lower part of which is U-shaped, and this U-shaped part supports the cross-beams



or putlogs. On the cross-beams or putlogs, the platform planks are placed. The frame also supports hoisting mechanism.

Combination patents would generally be valueless in the absence of a right to equivalents, for few combinations now exist, or can hereafter be made, which do not contain at least one element, an efficient substitute for which could readily be suggested by any person skilled in the particular art. (*Thrall v. Poole*, 89 Fed., 718, 721.)

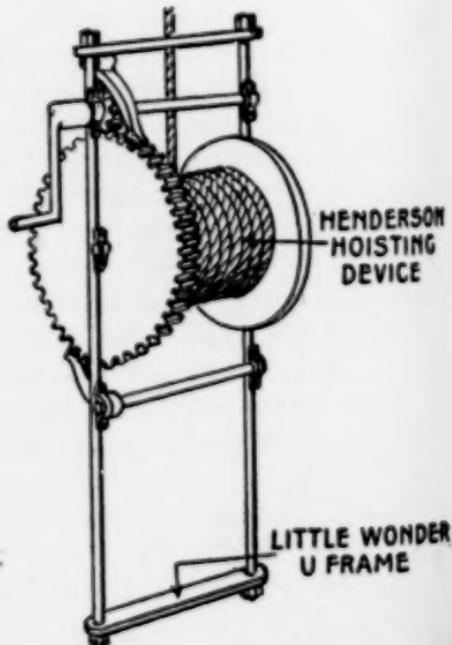
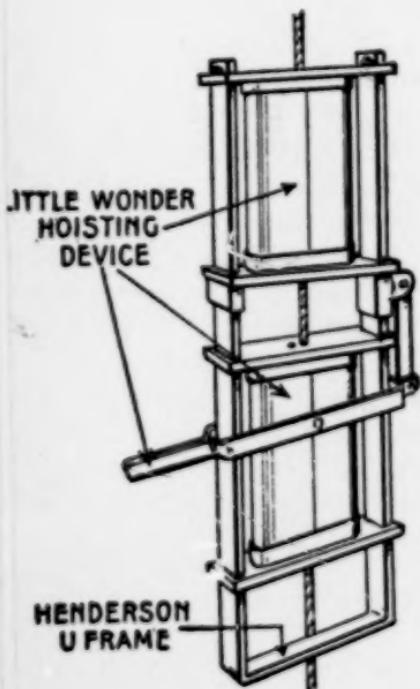
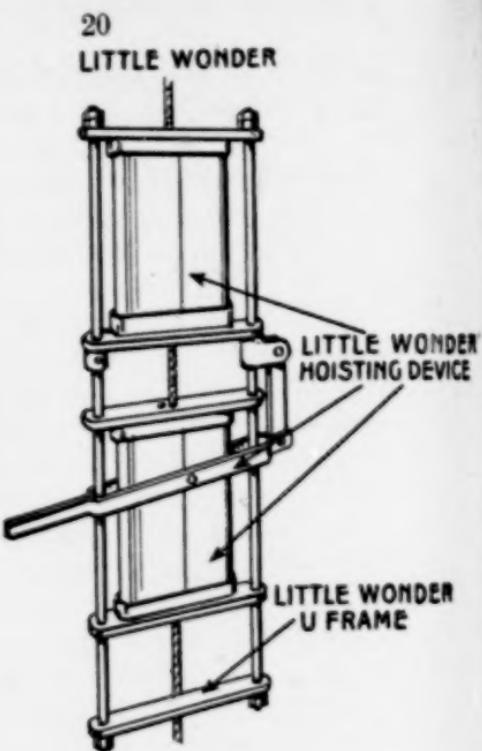
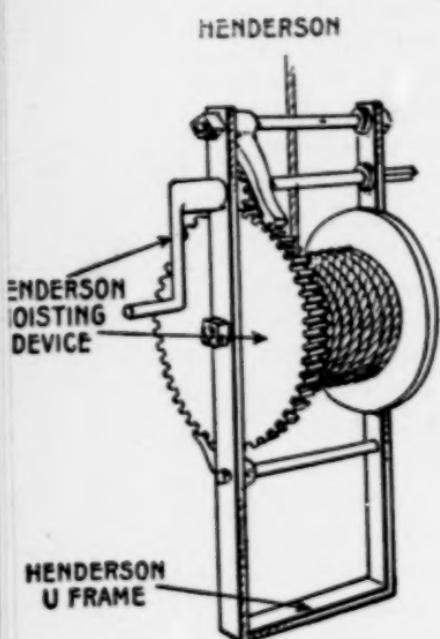
One thing to be an equivalent for another, must perform the same functions, as that other. (*Machine Co. v. Murphy*, 97 U. S., 120, 125, 24 L. Ed., 935, 936; *Rowell v. Lindsay*, 113 U. S., 97, 103, 28 L. Ed., 906, 908, 5 S. C., 507, 511; *Roller Mill patent*, 156 U. S., 261, 271, 39 L. Ed., 417, 421, 15

S. C., 333, 337.) One thing may be an equivalent of another, though it does more than that other (*Bliss v. Haight*, 3 Fisher, 621, 626).

Screws and wedges are equally inclined planes, while a lever is an entirely different elemental power. But screws and levers can practically be substituted for each other in a larger number of machines than screws and wedges can be similarly substituted. When a lever and screw can be interchanged and still perform the same functions with a result that is beneficially the same, they are said to perform the same function in substantially the same way. (*Turrell v. Spaeth*, 3 Banning & Arden, 458.) Springs and weights are generally equivalents. (*Imhaeuser v. Buerk*, 101 U. S., 647, 656, 25 L. Ed., 945.) While in most cases a mere handle is not an equivalent of a lever, it is such an equivalent when its connections are such that it performs the same function in substantially the same way. (*Corn Planter Patent*, 90 U. S., 23 Wall, 181, 235, 23 L. Ed., 161, 174.) And in *Blake v. Robertson*, 94 U. S., 728, 732, 24 L. Ed., 245, 246, this court held a defined column of water in a cylinder, worked by a pump and working a piston, to be an equivalent of a combination of vibrating arm, toggle joint, and other mechanical devices, when used to transmit vibratory power.

Tested by these authorities, the hoisting clutches of the "Little Wonder" machine, performing the same function as the drum, namely, to raise or lower the U-shaped frames, and arranged in the same environment, are the equivalent of the drum of Henderson.

The hoisting mechanism of the "Little Wonder" might be interchanged with the drum of Henderson.



And this test was applied in *Miller v. Eagle Co.*, 151 U. S., 186, 208, 38 L. Ed., 121, 131, 14 S. C., 310, 319, and infringement found.

Whether the defendant's device must have been known at the time of the invention of the machine which contains the latter, has not been passed upon by this court, though cases of this court seem to infer it. (*O'Reilly v. Morse*, 15 Howard, 62, 123, 14 L. Ed., 601, 628; *Burr v. Duryee*, 68 U. S., 1 Wall, 531, 573, 17 L. Ed., 650, 658; *Mason v. Graham*, 90 U. S., 23 Wall, 261, 275, 23 L. Ed., 86, 88; *Cochrane v. Deener*, 94 U. S., 780, 24 L. Ed., 139; *Union Paper Bag Machine Co. v. Murphy*, 97 U. S., 120, 125, 24 L. Ed., 935, 936; *Clough v. Mfg.*, 106 U. S., 178, 27 L. Ed., 138, 1 S. C., 198; *Cantrell v. Walliek*, 117 U. S., 689, 695, 29 L. Ed., 1017, 1019, 6 S. C., 970, 973; *Sickles v. Borden*, 3 Blatchf., 535; *Cahoon v. Ring*, 1 Cliff., 592, 620; *Roberts v. Harnden*, 2 Cliff., 500, 506; *Graham v. Mason*, 5 Fisher, 1, 11; *Harwood v. Mfg. Co.*, 3 Fisher, 526, 530; *Vogler v. Semple*, 7 Bissell, 382; *Potter v. Stewart*, 18 Blatch., 561, 563.)

In the case at bar, the hoisting mechanism of the two compared combinations is identical in function. Both raise or lower the frame. Both the drum and the clamps climb up and down on the cable. The drum clamps the cable, otherwise it would slip. The winding of the cable on the drum after sufficient is clamped to hold and wind, is immaterial, just as the cable below the clamps of the "Little Wonder" is immaterial.

Equivalency *per se*, therefore exists, without the necessity of giving any liberality to the patent.

SECOND: Especially is this so if the rule announced in *Cazier v. Mackie-Lovejoy*, 138 Fed., 654, 656, 71 C. C. A., 104, 106, states the law correctly. This case holds that the element least important as to the novelty of the combination is entitled to the greatest range of equivalents. It says:

"In claim 5, appellant's whole invention lay, it must be remembered, in the novel form and function of his *clamping jaws*. Having devised them, he could go to Killick, say, for the other elements of the combination, the hook, the suspending arms, and the locking link—old elements that were material only to the putting into use of the *real* invention. Appellant took Killick's preferred form of suspending arms—those with a spring instead of a hinge. May the appellee company appropriate the novel clamping jaws by using with them the less desirable form of suspending arms? We think not; most decidedly not. To hold otherwise would be to rob an inventor by a blind literalism."

The drum of Henderson is certainly only one means adapted for hoisting the frame and is only mentioned in the claim to have an operative claim and to show the *best* form. (*Grier v. Castle*, 17 Fed., 523.) But in *U. S. v. Societe Anonyme Des Anciens Etablissements*, 224 U. S., 309, 328, 56 L. Ed., 778, 787, 32 S. C., 479, 487, this court said a patent is entitled to equivalents whether so stated or not. And the hoisting jaws are simply another means adapted for hoisting the frame.

But this Court has not as yet had this identical ruling as made in *Cazier v. Mackie-Lovejoy*, 138 Fed., 654, 71 C. C. A., 104, before it, to wit: that the least important element is entitled to

the greatest range of equivalents. Somewhat to this point are *Adam v. Folger*, 120 Fed., 260, at page 263, 56 C. C. A., 540, 543, though not squarely held therein; as also *King Ax Co. v. Hubbard*, 97 Fed., 795, at 803, 38 C. C. A., 423, 431, though also not square to the point. Judge Taft in this last case cited *Sewall v. Jones*, 91 U. S., 171, 23 L. Ed., 275; but his case, though referred to by Judge Baker in the Cazier case, 138 Fed., 654, 71 C. C. A., 104, does not squarely pass on the rule as enunciated by Judge Baker in the Cazier case.

In the construction of Henderson, the drum is simply one form of hoisting mechanism which he thought best to describe in accordance with the Patent Act. But the *real invention*, his principle of invention, is in the arrangement of *pairs* of U-shaped frames or stirrups from a plurality of outriggers, along a building, and the placing in hinge-fashion of his cross beams or putlogs therein, and his platform planks on the putlogs. The operation and functioning of this platform scaffold, giving and yielding to the strains and stresses due to the workmen on the platform and the heavy materials thereon, is the same when using this combination whether the hoisting of the frames is brought about by the hoisting drum or the hoisting clamps.

That each element of a combination is entitled to equivalents was held in *Westinghouse v. Cutler Electrical Co.*, 143 Fed., 966, 75 C. C. A., 152, 3rd, and 169 Fed., 634, 95 C. C. A., 162, 3rd, and in *Westinghouse v. Condit*, 167 Fed., 546, 93 C. C. A., 224, C. C. A., 2nd, but the rule as announced in the Cazier case, 138 Fed., 654, 71 C. C. A., 104, is not so evident therein.

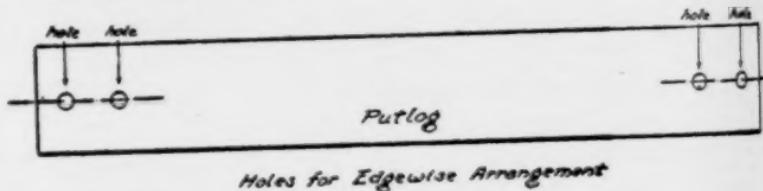
In the case at bar, this least important element is the well known drum, inserted into the claims to make them operative only, and the hoisting clamps of the "Little Wonder" are in all respects the equivalent of the drum performing the same function in the same manner, and when interchanged with the drum, serve to fulfill the same co-operative law underlying the claims. And it will be seen that the hoisting mechanism is the least important of the elements of the combination in respect to novelty, and should, therefore, have been given the greatest range of equivalents. Henderson's invention is, it must be remembered, the novel form and function of pairs of U-shaped frames connecting with crossbeams or putlogs in hinge-fashion. Having devised these, he added the other elements, the hoisting mechanism, the old element, that is material only to the putting into use of the *real* invention, and to make an operative claim. (*Cazier v. Mackie-Lovejoy*, 138 Fed., 654, 656, 71 C. C. A., 104, 106, 7th; also *King Axe Co. v. Hubbard*, 97 Fed., 795, 38 C. C. A., 423, 6th; *Adam v. Folger*, 120 Fed., 260, 56 C. C. A., 540, 7th). In so failing to apply equivalents to the separate elements of the combination, the Hon. Court of Appeals for the Seventh Circuit, enumerates a principle of patent law, contrary to the law as construed in the Second and Third Circuits (see *Westinghouse v. Cutter Electrical Mfg. Co.*, 143 Fed., 966, 75 C. C. A., 152, 3rd, and 169 Fed., 634, 95 C. C. A., 162, and *Westinghouse v. Condit*, 167 Fed., 546, 93 C. C. A., 224, 2nd), wherein these courts have ruled that separate elements of combination

claims are entitled to a range of equivalents, and counter to its own decision, in *Cazier v. Mackie-Lovejoy*, 138 Fed., 654, 656, 71 C. C. A., 104, 106, wherein it held that the least important elements, the elements that were important only to putting in use of the real invention, are entitled to a large range of equivalents. The doctrine underlying this case—that elements of a combination are each entitled to equivalents, with the least novel element entitled to the greatest range, held squarely in *Cazier v. Mackie-Lovejoy* Mfg. Co., 138 Fed., 654, has not, as yet, been squarely before this court. When the ideas necessary to success are made known, and a structure embodying those ideas is given to the world, it is easy for a skillful mechanic to vary the form, by mechanism which is equivalent, and is, therefore, in a case of this kind, an infringement.

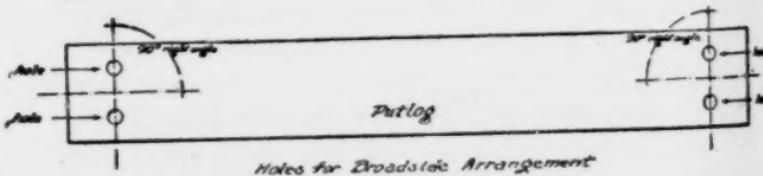
THIRD: The trial court, His Honor Judge Geiger, when this case came on for trial in open court, *heard and saw* the witnesses called to testify about prior use. He held that their testimony did not have that convincing force to establish a prior public use of the device testified about, following the well settled law of this court. (The Barbed Wire Patent, 143 U. S., 275, 293, 36 L. Ed., 154, 161, 12 S. C., 443.) But the Court of Appeals for the Seventh Circuit thought that "The evidence fairly establishes that in 1908, prior to Henderson's invention date, appellee who owns the Murray and other patents for scaffolds, and had built up a large business in the supplying of scaffolds for the erection of high buildings had furnished for the

erection of the Blackstone Hotel at Chicago, scaffolds in which there was the U-shaped bar frame similar to that of Henderson, but with putlogs composed of two angle irons bolted together, the U frame extending down between them and the connecting bolts resting on the top of the under web of the U, the floor boards of the scaffold being, as in Henderson, laid parallel to the building." But in so holding the Court of Appeals must have overlooked the law as stated in the Barbed Wire case.

FOURTH: The fact that the Court of Appeals for the Eighth Circuit thought that the holes in the "Little Wonder" putlog were edgewise of the plutog as in:



instead of broadside as the facts in the case showed:



led that court to consider the "Little Wonder" machine as an edgewise arrangement, instead of broadside, and so it permitted the "Little Wonder" to be free of infringement. The proven facts in the case at bar show that the defendant uses the "Little Wonder" broadside—an at-

tempt to use them edgewise proved a failure, and the user returned to the broadside arrangement. And such broadside arrangement brings the "Little Wonder" machine within the full scope and spirit of the opinion of the Court of Appeals for the Eighth Circuit, as reported in 224 Fed., 452, 140 C. C. A., 138, which the Court of Appeals for the Seventh Circuit followed, in holding the patent valid and infringed by the "Whitney Scaffold Hoist" machine. But the Court of Appeals for the Seventh Circuit also followed the later opinion of the Court of Appeals for the Eighth Circuit, which was based on the error of fact as to the edgewise arrangement instead of the broadside arrangement, as above pointed out. The broadside arrangement of the "Little Wonder" machine in the Henderson combination, brings about an exact equivalency of the mode of operation and functioning of the parts, with the clamps of the "Little Wonder" performing the identical function, as above pointed out, as the drums of Henderson.

FIFTH: The contrary decisions of the Seventh and Eighth Circuits holding the patent valid, on the one hand, and that of the Third Circuit holding it invalid, on the other hand, bring up a novel point in patent law. This point has not been decided by this Court, and is of great importance to the jurisprudence relating to patents. It is this:

With one decision of one Circuit Court of Appeals holding the patent valid and infringed by a defendant, and another decision holding the same patent on the same issues invalid in favor of the *same* defendant, which decision controls?

Is the decision holding the patent valid control-

ling, to bar further infringement by this defendant or, is the decree of dismissal a bar in favor of this *same* defendant to allow him "everywhere and always" to infringe?

The nearest cases in answer to these questions are *Kessler v. Eldred*, 206 U. S., 285; *Diamond Co. v. Consolidated*, 220 U. S., 428; but both of these cases expressly say they do not decide this point.

In *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 S. C., 611, it was said by the Hon. Court:

"It may be that the judgment in *Eldred v. Kessler* will not afford Breitwieser, a customer of Kessler, a defense to Eldred's suit against him, upon that question we express no opinion. Neither it nor the case in which it is raised are before us."

In *Diamond Co. v. Consolidated*, 220 U. S., 428, 55 L. Ed., 527, 31 S. C., 444, it was also said:

"The final contention of the rubber company is that, the Grant patent having been declared invalid by the Circuit Court of Appeals for the Sixth Circuit and by the Circuit Court for the District of Indiana in the Seventh Circuit, the rubber company should not have been enjoined from the handling or sale of tires manufactured in the sixth and seventh circuits, and cites *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed. 1065, 27 Sup. Ct. Rep., 611."

We respectfully ask, therefore, that this petition be granted to enable this important point in patent law to be finally settled.

Conclusion.

We respectfully ask for the granting of this petition, for the reason that,

(a) A new point of patent law has not been heretofore adjudicated by this court, and we urge it as follows:

That in a combination claim, each element is entitled to equivalents to embrace another combination embodying the same co-operation law, and *the least important element in novelty is entitled to the greatest range of equivalents.* (Cazier v. Mackie-Lovejoy, 138 Fed., 654, 656.)

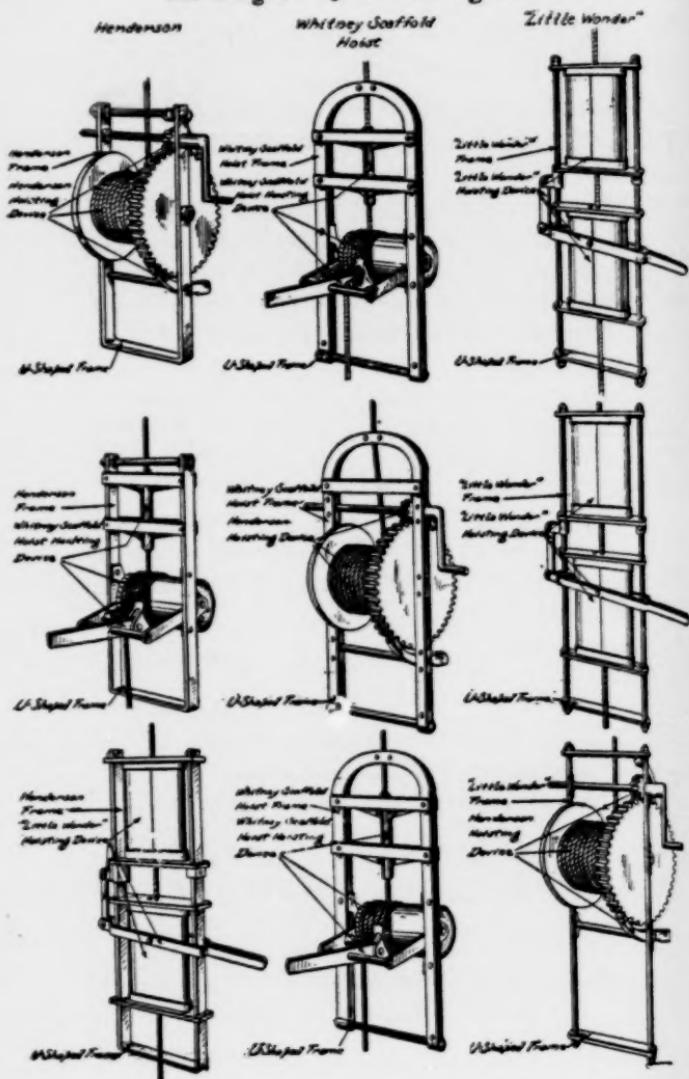
(b) A further new point in patent law has not been heretofore adjudicated by this court, and it is:

In case of conflicting decrees of different circuit courts of appeals against the *same* defendant on the same issues, which decree against the defendant should be controlling?

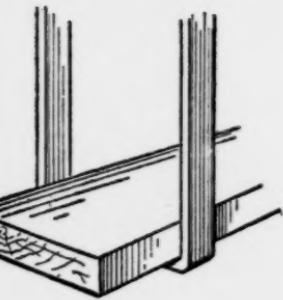
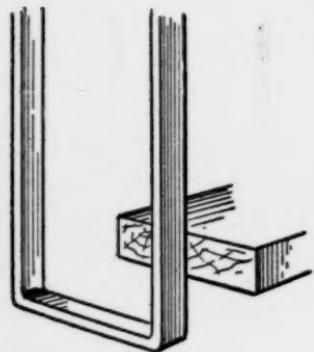
Respectfully submitted,

C. P. GOEPEL,
F. C. SOMES.

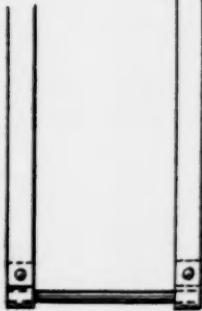
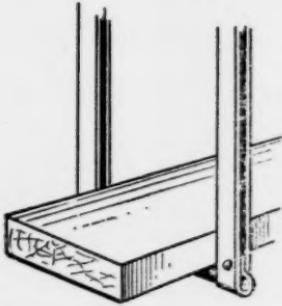
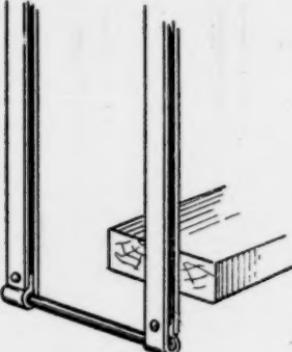
Interchangeability of Hoisting Devices



Henderson
U-Frame



Whitney Scaffold
Hoist Machine Frame



"Little Wonder"
U-Frame

